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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,930	12/09/2003	Chiu-Fu Cheng		2432

7590  
Chiu-Fu CHENG  
P.O. Box No. 6-57  
Junghe  
Taipei, 235  
TAIWAN

01/11/2006

EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/729,930

Applicant(s)

CHENG, CHIU-FU

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 5, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

Further, the phrase "and so on" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and so on"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding claim 6, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3728

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Youngs (US 4,850,731).

Claim 1: Youngs discloses a compact disc protective sleeve **10** comprising a first surface layer **40**, a second surface layer **30**, and intermediary layer **24** conterminously sealed at the bottom edge **32** and two side edges **32** to compartmentalize the package. The package has an open top and first surface layer **40** has an extended flap **44**, which can fold over the openings of the compartments to form a closed package.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tullar (US 1,369,503) in view of Youngs.

Tullar discloses a package (see Figures 1 and 7) with a first surface layer (middle panel of Figure 7 and panel **B'**), and a second surface layer (panel of Figure 7 retaining tab **C**) conterminously sealed at the bottom edge and two side edges (see Figure 1). The package is inherently capable of retaining compact discs and comprises a first surface layer (middle panel of Figure 7 and panel **B'**) having an extended flap **B'**, which can fold over the open top to form a closed package with a gap and retainer tab **C** as claimed. Tullar merely lacks the intermediary layer.

Youngs teaches an intermediary layer **24**. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the package of Tullar with an intermediary layer as taught by Youngs in order to retain a plurality of products in a separate nature.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Youngs in view of Durr (US 5,662,217).

Youngs, as applied to claim 1 above, discloses the claimed invention except for the insertion slot.

Durr discloses a compact disc package **1** with trapezoidal closure flap **28** and insertion slot **26** located near the top edge of the package (see Figure 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to

Art Unit: 3728

provide the package of Youngs with a trapezoidal-shaped closure flap and an insertion slot as taught by Durr in order to maintain the closure flap in a closed position.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Youngs in view of Friedman (US 5,042,841).

Insofar as the examiner can determine the scope of the claim, Youngs, as applied to claim 1 above, discloses the claimed invention except for the mutually fastenable components.

Friedman discloses a package **10** with a closure flap **26** mutually fastenable components **40 & 42**. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the second surface layer and closure flap of Youngs with mutually fastenable components as taught by Friedman in order to maintain the flap in a closed position. The mutually fastenable components of Friedman comprise hook-and-loop fasteners.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Youngs.

Insofar as the examiner can determine the scope of the claim, Youngs, as applied to claim 1 above, discloses the claimed invention except for the plurality of intermediary layers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide additional intermediary layers in order to provide a greater number of storage compartments. It has been held that mere duplication of

Art Unit: 3728


the essential working parts of a device involves only routine skill in the art. St. Regis Paper Co. v. Bemis Co., 193 USPQ 8.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gregory Pickett  
Examiner  
6 January 2006

  
Mickey Yu  
Supervisory Patent Examiner  
Group 3700